



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,661	09/13/1999	MASAAKI TSUJI	2271/60220	4670

7590 11/10/2003

RICHARD F JAWORSKI
COOPER & DUNHAM LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
----------	--------------

2175

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/394,661

Applicant(s)

TSUJI, MASAOKI

Examiner

Sam Rimell

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

SAM RIMELL

PRIMARY EXAMINER

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1: The first paragraph calls for subcomponent data "which indicates at least one of time information and information other than time information." The next two paragraphs of the claim indicate that the subcomponent data will in fact include both types of data (time data and non-time data). Thus, the quotation in the first paragraph is inconsistent with the next two paragraphs of the claim, since the quotation in the first paragraph indicates that the two types data are optional and the next two paragraphs indicate they are both mandatory.

Claim 3: The first paragraph calls for subcomponent data "which indicates at least one of time information and information other than time information." The next two paragraphs of the claim indicate that the subcomponent data will in fact include both types of data (time data and non-time data). Thus, the quotation in the first paragraph is inconsistent with the next two paragraphs of the claim, since the quotation in the first paragraph indicates that the two types of data are optional and the next two paragraphs indicate that they are mandatory. The fifth and sixth paragraphs refer to "commands", whereas it is not clear whether these "commands" are the same as or different from the "first generating portions" or "second generating portion", which could also be viewed as software commands.

Claim 5: The statement "said subcode component data alternating between the high state and the low state at the predetermined period, based on a number of sectors relating to pre-

Art Unit: 2175

alternating data of the subcode component data.” This statement is vague and confusing for several reasons: (1) It is not clear whether it is the selection of subcode data or the alternating period that is based on “the number of sectors”. (2) It is not clear what the sectors refer to, since there are no recited structures containing sectors, or data substrate previously recited in the claim. (3) It is not clear what the “pre-alternating data” refers to. Is this non-alternating data or alternating data that was generated previously by the subcode generator at some unknown previous time?

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, as best as can be understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Kawamura et al. (U.S. Patent 6,075,920).

Claim 1: FIG. 1 of Kawamura et al. discloses a control unit (20) which controls a first generating portion (9) which generates time code information, and control a second generating portion (schematically indicated by right arrow from control unit 20) that generates non-time-code information, such as sector number, copyright management information, track number, application ID number, application information and layer information. The time code information and non-time-code information are each components of subcode that are entered into a subcode generator (11) which outputs subcode. The control unit maintains controls over the

Art Unit: 2175

output of the time code information and non-time-code information, and thus can be read as a selecting portion which selects output.

Claim 2: The second generating portion outputs six types of data, and can thus be said to comprise a plurality of generating portions.

Claim 3: See remarks for claim 1. Also note table of FIG. 6, which is a data table in memory having separate table locations (memory areas) for metadata (commands) associated with the time code data and non-time code data.

Claim 4: See claims 2-3.

Claim 5: The time code generating portion (9) and the generating portion indicated by the right arrow extending from the control unit (20) are readable as toggle generating portions since they generate subcode components which are delivered to the subcode encoder (11). The subcode can be said to "toggle" in the sense that it is created by changing a field of bits to a different field of bits. For example, FIG. 18 indicates that the subcode for the track number occupies a field having a length of 2 bytes. The field is inherently changed when the field gets encoded with track number information. Thus, the subcode field containing this information can be said to toggle between an uncoded "low" state and an encoded "high state". The control unit (20) reads as the selecting portion since it maintains control over the entry of subcode components into the subcode encoder (11).

Remarks

Applicant's arguments and amendments have overcome the rejection under 35 USC 101 and certain rejections under 35 USC 112 second paragraph. However, certain rejections under 35

Art Unit: 2175

USC 112 second paragraph remain, and applicant's amendment to claim 5 add certain additional grounds of rejection under 35 USC 112.

Applicant argues that the present invention distinguishes from Kawamura et al. in that the present invention generates the first subcomponent information (time information) and second subcomponent information (non-time information) automatically. However, Examiner finds that this is exactly what occurs in Kawamura et al. The time code information (9) and non-time code information (right hand arrow from control unit (20) are in fact generated automatically, as there is no suggestion in Kawamura et al. that it is entered by a manual operator.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Application/Control Number: 09/394,661

Page 6

Art Unit: 2175

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.

A handwritten signature in black ink, appearing to read 'S. Rimell', written in a cursive style.

Sam Rimell
Primary Examiner
Art Unit 2175